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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 10/051,573
Filing Date: January 17, 2002
Appellant(s): ROBERT W. LUFFEL ET AL.

Bruce E. Dahl, Esq.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 02, 2003

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) Issues

The appellants' statement of the issues in the brief is essentially correct. However, upon further consideration in light of appellants' appeal brief, the Section 102(b) rejection of claims 1, 9, 11, and 13-16 based on Cherry has been withdrawn. Thus appellants' listed issue No. 2 is no longer an issue before the Board.

(7) Grouping of Claims

With respect to the Section 112 second paragraph rejection, claims 1-14 and 16-21 stand or fall together as one group and claim 15 is a second group.

With respect to the Section 102(b) rejection based on Whiten et al., the grouping of claims are as follows: Claims 1, 14, and 16; claim 2; claim 3; claim 4; claim 7; claim 8; claim 9; claim 11; claim 12; claim 13; claim 15; claim 17; claim 18; claim 19; and claim 21.

With respect to the Section 103(a) rejection base on Whiten et al. in view of Robertson et al., the grouping of claims are as follows: Claim 5; claim 6; and claims 10 and 20.

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,806,417	WHITEN et al.	09-1998
5,788,091	ROBERTSON et al.	08-1998

(10) *Grounds of Rejection*

The following grounds of rejection are applicable to the appealed claims:

Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 14, 15, and 16, are vague and indefinite because it appears that these claims are setting forth the same disclosed structure multiple times under different name terminologies. Note "device"/ "device means" and "housing"/ "chassis"/ "housing means" and then note the drawings which show "16" and "48" identifying the same structure. Thus, these claims improperly include duplicate recitations of the same disclosed element.

Specifically with respect to claim 1, line 4, sets forth a first "device" that defines a mounting pathway while lines 5-7 set forth that this "device" includes a "chassis" which defines at least a portion of the mounting pathway. However, as is clearly shown in the drawings, the "device" includes and "chassis" each refer to the same rectangular housing structure that has a recessed channel in the bottom thereof defining the mounting pathway. For example, see Figures 2 and 3. Thus, both terms refer to the same disclosed structure and improperly doubly include said disclosed structure as only the housing structure defines the pathway (18).

Claims 14-16 are similar to claim 1 with claim 15 using the terminology of "device means" and "housing means".

Claims 1-4, 7-9, 11-19, and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Whiten et al. Whiten et al. disclose a rack-mount storage system that reads on the language of the instant claims.

With respect to claim 1, Whiten et al. disclose a rack-mount storage system that comprises an equipment cabinet (see Figure 1) having a first side (14) and a second side (10), the equipment cabinet defining at least one device opening therein (e.g., note column 3, line 10); a first device (58, B) sized to be received by the device opening, the first device defining a first mounting pathway therein (e.g., note column 5, lines 5-7 and 14-15), the first device having a first chassis (58) sized to receive at least one component (B) of the first device, at least a portion of the first chassis defines at least a portion of the first mounting pathway (e.g., note column 5, lines 5-7); and a support spar (54) sized to be received by the first mounting pathway and the equipment cabinet (see Figure 1), the support spar engaging the first mounting pathway and equipment cabinet and extending substantially transversely between first and second sides of the equipment cabinet to support the first device therein.

With respect to claim 2, the first chassis (58) comprises a top surface (62), a bottom surface (defined by rails 64) and a channel member therein (the wall surfaces in the sides 10, 14 that define the rectangular apertures). The first mounting pathway is defined by the channel member and the bottom surface such that the support spar received therein does not extend downwardly beyond the bottom surface (see Figure 1).

With respect to claim 3, see the explanation for claim 2, above, and further note that the support spar also does not extend upwardly beyond the top surface.

With respect to claim 4, the first device of Whiten et al. includes a fore-to-aft center of gravity location (inherent in all things) and, as shown by Figure 1, the first mounting pathway is located at “about” this center of gravity location. Note that “about” is a very general relative term that does not require actual location at the exact fore-to-aft center of gravity location and the first mounting pathway of Whiten et al. is shown to be within the middle third of the first chassis.

With respect to claim 7, the support spar engages the first and second sides of the equipment cabinet via the adapter member (40) and uprights (20, 22). Note that the indirect engagement interpretation advanced by the examiner is entirely consistent with the instant disclosure that indicates that appellants’ support spar engages the first and second sides via mounting rails (32, 34), see page 6, lines 14-22, and page 15, line 20, through page 16, line 22.

With respect to claim 8, the adapter members (40) of Whiten et al. constitute the first and second mounting rails of the respective first and second sides.

With respect to claim 9, Figure 1 of Whiten et al. clearly establishes the first device has a width that is less than the spaced distance between the first and second sides of the device opening of the equipment cabinet.

With respect to claim 11, Figure 1 of Whiten et al. clearly illustrates a second device (58).

With respect to claim 12, the first device is secured to the second device via the support spar.

With respect to claim 13, Figure 1 of Whiten et al. clearly illustrates the second mounting pathway is substantially aligned with the first mounting pathway when the first and second devices are positioned adjacent one another.

With respect to claim 14, Whiten et al. disclose a rack-mount storage system as previously advanced with respect to claim 1.

With respect to claim 15, Whiten et al. disclose equipment cabinet means for defining at least one device opening (note column 3, line 10), device means (58, B) for defining at least one mounting pathway therein (e.g., note column 5, lines 5-7 and 14-15), the device means having housing means (58) for housing at least one component (B) of the device means, the housing means defining at least a portion of the mounting pathway, and support means (54) for engaging the mounting pathway and equipment cabinet means and for extending transversely between first and second sides, the support means supporting the device means with the device opening.

With respect to claim 16, see the discussion of Whiten et al. for claim 1.

With respect to claim 17, see the discussion for claim 2.

With respect to claim 18, see the discussion for claim 3.

With respect to claim 19, see the discussion for claim 4.

With respect to claim 21, see the discussion for claims 9 and 11.

Claims 5, 6, 10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whiten et al. as applied to claims 1-4, 7-9, 11-19, and 21 above, and further in view of Robertson et al. Robertson et al. teach a support spar (52, 46, 48) having first and second ends, a center, and a spacer sleeve (52) that is sized to fit over

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the center of the support spar (48). The support spar center with the spacer sleeve (52) being curved or formed of an upward curved portion such that the center of the support spar is being higher than both ends of the support spar (48). See Figures 1 and 2. It would have been obvious to one of ordinary skill in the art at the time of invention was made to provide the supporting spars of Whiten et al. with spacer sleeves as taught by Robertson et al. in order have supporting spars that promote adjustability to accommodate different length between first and second sides of the cabinet. With respect to claim 5, aluminum is a well-known and commercially available material known for its lightweight properties. Accordingly, it would have been obvious to one ordinary skill in the art as a matter of engineering design choice to utilize aluminum as the particular material for constructing a support spar because of its durability and light weight and because it is well-within the level of skill in the art to utilize the known features of the art for the purpose for which they are known.

(11) Response to Argument

Response to Argument under 35 USC § 112 rejections:

With respect to applicants' argument that references numerals (16 and 48) pointing to the same element in the drawings is not the same as saying they are the same element since the specification conveys that the device and the chassis as two separate structures. This argument is not found to be persuasive.

With respect to the terminology of "device" and "chassis"/"housing", it is noted that the specification refers to "device 16" and "housing or chassis 48". At the same

time, Figures 2 and 3, especially Figure 3, have reference numerals "16" and "48" pointing to the same illustrated structure. The specification at page 5, lines 11-12, stated that the device 16 is provided with a "mounting pathway 18" and that this pathway is recessed within the device 16, see page 5, lines 15-17. On page 5, lines 28-29, it is stated that the device 16 may be provided with a housing/chassis 48. Page 6, lines 5-8, stated that the chassis 48 is provided with a first channel member 56 which "defines the first mounting pathway 18". Thus, the specification first discloses the "mounting pathway 18" provided with the device and then discloses that the same "mounting pathway 18" is defined by the chassis 48. It appears to the examiner that the exact same structure is being referred to.

Appellant alleges that the examiner is ignoring the various figure showings which allegedly establishes the "16" and "48" point to different portions of the illustrated structure. This is hardly the case and, in fact, the different locations of reference numerals 16 and 48 in the figures merely further confuse the issue.

A review of Figure 2 established that "16" is pointing to the upper, right side, middle section of the rectangular housing structure while "48" is pointing to a rear area of the same housing structure. Figure 3 then shows both "16" and "48" pointing to the left front top section of the exact same housing structure. Figure 1 shows "16" pointing to the top front of the housing structure. Figure 5 has "16" identifying the left side wall of the housing structure while "48" is not present. Figure 6 has both "16" and "48" pointing to the upper right side of the housing structure with "16" being more in the middle and "48" being located forward of the middle. Accordingly, what two different structures are

being shown? The examiner fails to see any distinction present in the drawings and it appears to be quite evident that only one housing structure is present. The "device" is the "chassis" as shown.

Applicants' reference to the use of other numerals that identify subcomponents of the "device"/ "chassis" as somehow establishing a lack of indefiniteness is not persuasive and not well taken. Reference to a top, bottom or side surface of the "chassis" does not cause confusion and appellants have not recited a "chassis" and then these same surfaces as separate elements in addition to and apart from the chassis.

Further, with respect to claim 15, appellants' alleged that the "means" are presented in proper format and there is no ambiguity or double inclusion. However, claim 15, line 3, recites "device means for defining at least one mounting pathway therein" while lines 5-6 recite "said housing means defining at least a portion of said at least one mounting pathway". Thus, two elements have been recited to be performing the same function while the disclosure indicates only one structural element that defines the mounting pathway. Where is the second disclosed element? The current claim language either includes redundancies or doubly includes the same disclosed element.

Response to Argument under 35 USC § 102 rejections:

At the outset, it should be noted that anticipation by a reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed thereby and a prior art reference anticipates the

subject matter of a claim whenever the reference discloses every feature of the invention as claimed. Specifically, the law of anticipation does not require that the reference teach what is being claimed. Rather, it is only necessary for the claims to "read on" something disclosed in the reference for anticipation to exist. See *Kalman v. Kimberly-Clark Corporation*, 218 USPQ 781 (CFAC 1983).

Appellants' first allege that the Section 102(b) rejection based Whiten et al. is improper because Whiten et al. fail to disclose "a first device having a chassis sized to receive at least one component of said first device" (see second paragraph of page 12 of the brief). Appellants' allegations to the contrary notwithstanding, Whiten et al. do, in fact, disclose a first chassis (58) sized to receive at least one component (B) of the first device. In this regard, it should be noted that the claims clearly establish that the "chassis" is a part of the "device" and that the "device" will include at least one additional "component". However, no actual "at least one component" is required because the recitation states that the first chassis is "sized to receive at least one component of said first device" (emphasis added). Thus, the actual recitation is setting forth some size requirement for the first chassis and not "at least one component" in addition to the chassis.

Furthermore, the actual structure that constitutes the "component" is not defined in the claims, and it is axiomatic that limitations not present in the claims will not be read therein from the specification or some other source. The examiner finds nothing in the claims that precludes the bottles (B) from constituting the inferentially recited "at least one component" of the first device (assuming that the "component" should be a part of

the claims) and appellants' general statement of denial offers no further insight.

Apparently, appellants are relying upon the specification, or some other source, to impart to the claims limitations not recited therein. This reliance is ineffective.

Accordingly, for each of the independent claims, it is first noted that no "component" is being set forth and thus Whiten et al. are not required to disclose any specific "component". Rather, these claims either set forth a size requirement for the chassis (claims 1, 14, and 16) or merely recite a "means" which performs the function of "housing" at least one component (claim 15). The chassis (58) of Whiten et al. does possess a sizing that enables receipt of "at least one component" and serves as a "housing means". Second, assuming arguendo that "at least one component" is being required, then Whiten et al. clearly disclose that the chassis (58) receives at least one component (B) and also constitutes a housing means for housing the at least one component. Further, nothing in these claims precludes the bottles (B) of Whiten et al. from constituting the "at least one component" and being a part of the structurally undefined "device" or "device means". The language of the claims has been presented in such a manner that the claims "read on" the storage system of Whiten et al.

With respect to claim 2 and 17, appellants' argument is based on the allegation that Whiten et al. do not possess a "chassis" and therefore cannot possess the additional chassis limitations. See the paragraph bridging pages 12 and 13 of the brief. This argument has not been found to be persuasive because claim 2 clearly defines what a "chassis" is and the disclosed track 58 of Whiten et al. clearly meets the

limitations of the claim. Moreover, aside from the general expression of denial, there is no discussion of why track 58 does not, and cannot, constitute the recited "chassis".

The same general allegation is made for claims 3 and 18, and is also not persuasive for the same reasons discussed above in regard to claims 2 and 17.

With respect to appellants' argument on pages 13 and 15 regarding claims 4 and 19, it should be noted that all objects possess a center of gravity as an inherent law of physics. Further, it is well-established that drawings may be relied upon to show relative dimensioning. Figure 1 of Whiten et al. illustrates the support spar (and therefore the mounting pathway) to be located about a third of the way back from the front. The center of gravity of uniform object would be about half way back from the front. Thus, the mounting pathway of Whiten et al. is seen to be at "about" the location of the center of gravity. Further still, it should be noted that "about" is a very general term that permits deviation and thus claim 4 is not requiring exact, or even essentially exact, location of the mounting pathway at the center of gravity location.

Appellants' comments regarding claim 7 are acknowledged. Unfortunately, these comments are not commensurate with the scope of the claims and are not even commensurate with appellants' own disclosure. Specifically, there is no requirement for a "direct" engagement of the support spar to the cabinet sides. Further, appellants' own support spar is clearly disclosed as not directly engaging the cabinet sides. For example, on page 6, lines 17-22, it is clearly stated that the support spar extends between mounting rails (32, 34), which are affixed to the sides (28, 30). Further, it's clearly stated that the device (16) is "supported on the one side directly by the first

mounting rail 32 and on the other side by the second mounting rail 34 via spar 20". See the sentence bridging pages 15 and 16. Accordingly, it's quite clear that "direct" engagement is not required by claim 7 and that appellants contemplate the use of some intermediate rail member to "engage" the spar to the respective cabinet side. No difference is seen between the use of appellants' mounting rails (32, 34) and Whiten et al's adapter members (40) and appellants have offered no explanation for their general denial.

Contrary to appellants' allegation regarding claim 8, the adapter members (40) of Whiten et al. constitute "mounting rails" as is claimed. Appellants' general denial without explanation is wholly insufficient when the prior art elements have been shown to meet the recitations of the claim.

With respect to the remaining dependent claims, appellants' continue to make unsubstantiated and unsupported allegations that amount to nothing more than very general statements of denial. For example, Figure 1 of Whiten et al. clearly contradicts appellants' allegation regarding claims 9, 11-13, and 21.

Response to Argument under 35 USC § 103 rejections:

With respect to appellants' argument to the Section 103 rejection that neither reference provides the suggestion or incentive required to combine the references in a manner that would make obvious the pending claims, this argument is not found persuasive because a combination of references is proper for any reason taught by the prior art and there is no requirement that references be combined for the same reason

as appellants. Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this instance, Robertson et al. has been applied to teach a support spar (52, 46, 48) having first and second ends, a center, and a spacer sleeve (52) that is sized to fit over the center of the support spar (48). The support spar center with the spacer sleeve (52) being curved or formed of an upward curved portion such that the center of the support spar is being higher than both ends of the support spar (48). See Figures 1 and 2.

For all of the above reasons, the rejection should be sustained and affirmation thereof is requested.

Respectfully submitted,

KT

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May 27, 2004

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